

**REMARKS**

Claims 18-27 and 45-79 are all the claims pending in the application. Claims 1-17 and 28-24 have been canceled without prejudice or disclaimer. New claims 49-79 have been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

**Election of Species**

Previously, Applicants have elected the Species of Figs. 27A and B, upon which claims 1-17, 47 and 48, were readable. In this amendment, claims 1-17 have been canceled, but new claims 49-79 are based on claims 1-17 and, therefore, are readable on the elected species. Specifically, new claims 49-79 include the subject matter of claims 1-17 as follows:

New Claim(s)	Previous Claim(s)
49	1 and 3, but not 2
50	1 and 4, but not 2
51	5
52	6
53	7
54	8
55	9
56-59	2
60-61	10
62-63	11
64-65	12
66	13
67-70	14
71-74	15
75-78	16
79	17

**Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 47 and 48 under §112, 2<sup>nd</sup> paragraph, as indefinite. Accordingly, Applicants have amended claim 47 in a manner believed to overcome this rejection.

**Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claims 1-3, 14, 15, and 16, under §102(a) as being anticipated by US Patent 4,688,951 to Guers (hereinafter Guers). In as much as the Examiner may now attempt to apply this rejection to claim 49, Applicants respectfully traverse this rejection because Guers fails to disclose every element as set forth in Applicants' claims.

Claim 49 sets forth a rolling bearing with sensor, comprising: an inner ring; an outer ring; a plurality of rolling elements; and a sensor having a detecting part and a circuit part connected to the detecting part, wherein the detecting part and circuit part are attached to the rolling bearing, and wherein at least one of the detecting part and the circuit part is attached to at least one of the inner and outer rings along a circumferential direction thereof.

For example, as shown in Figs. 27A and B, one embodiment consistent with claim 49 is a rolling bearing 291 with sensor 209, comprising: an inner ring 203; an outer ring 202; a plurality of rolling elements 205; and a sensor 209 having a detecting part 210 and a circuit part (one of 211-213) connected to the detecting part, wherein the detecting part 210 and circuit part (one of 211-213) are attached to the rolling bearing, and wherein at least one of the detecting part and the circuit part is attached to at least one of the inner and outer rings along a circumferential direction thereof.

In contrast to that set forth in claim 49, Guers discloses a probe 8 that is provided with rolling bearing 10 via deflector 5. Accordingly, Guers fails to disclose at least one of a detecting part and a circuit part is attached to at least one of the inner and outer rings along a circumferential direction thereof. Further, although probe 8 may be a detecting part, it is not connected to a circuit part that is also attached to the rolling bearing 10. Instead, probe 8 is shown as having wires leading away from the rolling bearing. Moreover, coil 17 forms part of an electric generator that supplies voltage to regulator 19, battery 21, amplifier 22, and or sensor

23, which in turn supplies electric to winding 11 or coil 12 so as to generate a magnetic field which may then be detected by probe 8. However, elements 17, 19, 21, 22, 23, 11 and/or 12 do not comprise a detecting part but, instead, a circuit for creating a magnetic field.

For at least any of the above reasons, claim 49 is not anticipated by Guers. Likewise, dependent claims 56, 67, 71, and 75, are not anticipated by this reference.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 4, 5, and 10, under §103(a) as being unpatentable over Guers, and further in view of Official Notice of common knowledge in the art, or, in the alternative, engineering design choice. In as much as the Examiner may now attempt to apply this rejection to claim 50, Applicants respectfully traverse it for the following two reasons.

First, the Examiner procedurally has failed to establish *prima facie* obviousness by failing to fully explain the rejection. Yet, the Office Action must explain with reasonable specificity at least one rejection, otherwise the Office Action procedurally fails to establish *prima facie* obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). See also MPEP § 2142. That is, when the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Interf. 1986). Here, the Examiner makes the bald assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the features in question since it was known in the art to do so to provide the functions disclosed.”<sup>1</sup> Accordingly, contrary to established Patent Office procedure, the Examiner has failed to present a cogent line of reasoning as to why one of ordinary skill would provide the “features in question”, let alone specifically what are those “features in question”. The Office Action thus fails, procedurally, to establish *prima facie* obviousness.

Second, Guers fails to teach or suggest all the elements as set forth in the claims.

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<sup>1</sup> Office Action at page 4, 1<sup>st</sup> full paragraph.

Claim 50 sets forth a rolling bearing with sensor, comprising: an inner ring; an outer ring; a plurality of rolling elements; and a sensor having a detecting part and a circuit part connected to the detecting part, wherein the detecting part and the circuit part are attached to the rolling bearing, and wherein at least one of the detecting part and the circuit part is attached to an end face of at least one of the inner and outer rings.

Again, as set forth above, Guers fails to teach or suggest a detecting part connected to a circuit part, wherein the detecting part and circuit part are attached to the rolling bearing, and wherein at least one of the detecting part and the circuit part is attached to at least one of the inner and outer rings.

For at least any of the above reasons, Guers fails to render obvious Applicants' claim 50. Likewise, this reference fails to render obvious dependent claims 51, 57, 68, 72 and 76.

#### **Information Disclosure Statement (IDS)**

On each of April 25 and July 18, 2003, Applicants submitted an IDS. Because these IDSs were submitted before the first office action mailed on June 4, 2003, they were timely submitted. Accordingly, applicants respectfully request that the Examiner consider these IDSs and return—with his next Office Action—an initialed copy of the PTO form 1449 submitted with each.

#### **Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 6-9, 11-13, and 17, would be allowable if rewritten in independent form. Accordingly, claims 52-55, 58-66, 69-70, 73-74, and 77-79, should now be allowable. Further, with respect to claims 47 and 48, because the rejection under §112 is believed to have been overcome, and there were no other rejections of these claims, they are now believed to be allowable.

#### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

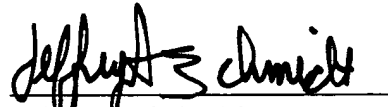
Amendment Under 37 C.F.R. § 1.111  
US Appln. 09/985,921

Atty. Docket: Q67064

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Schmidt", written over a horizontal line.

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